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Laba Karki, Ph.D.
Morgan Lewis & Bockius, LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004

In re Application of
SMALL, et al.
Serial No.: 10/568,077
PCT No.: PCT/US04/25913
Int. Filing Date: 12 August 2004
Priority Date: 14 August 2003
Atty Docket No.: 0632540203US
For: PERIODIC ACID COMPOSITIONS FOR
POLISHING RUTHENIUM/LOW K
SUBSTRATES

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to the "Petition Under 37 C.F.R. §1.47(a)" filed 17 May 2007 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Haruki Nojo. Applicant has authorized charging of the \$200.00 petition fee to deposit account number 50-0310.

BACKGROUND

On 12 August 2004, applicant filed international application PCT/US04/25913 which claimed priority to a previous application filed 14 August 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 14 February 2006.

On 13 February 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and an Information Disclosure Statement.

On 18 October 2006, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 17 May 2007, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time. With payment of the five-month extension of

time applicant's present response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), applicant has provided a firsthand statement showing that a complete set of the application papers was mailed to Mr. Nojo's last known address and that to date he has not responded. In addition, applicant has shown that additional, unsuccessful, attempts were made to contact the inventor by telephone and email. However, it is not possible to accept the inventor's silence as a refusal at this time. Specifically, there is a question as to the whereabouts of Mr. Nojo. The Federal Express parcel which contained the complete set of application papers was signed for by a "N. OUJOU." This, coupled with the fact that Mr. Nojo has left his last employer and not responded to email and phone inquiries calls into question whether Mr. Nojo resides at the address to which the papers were sent. Before the inventor's silence can be considered a refusal in the present case applicant should search for an other current addresses for Mr. Nojo and send papers to the new address if found or alternatively submit the search results showing that despite diligent effort no new address could be located.

As stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts."

Regarding item (4), the filed declaration does not comply with 37 CFR 1.497 (a)-(b). Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains two pages "2 of 2." This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2)** **MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 571-272-3294
Fax: 571-273-0459